

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-2 and 4-19 were pending prior to this Reply. Claims 20-33 are added. Therefore, claims 1-2 and 4-33 are pending. Claims 1, 8, 11 and 26 are independent.

§ 103 REJECTION – MIYAWAKI, SOOHOO

Claims 1-2, 4, 6-8 and 9-19 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Miyawaki et al. (USP 6,522,360) in view of Soohoo (USP 5,754,348). *See Final Office Action, items 2-3.* Applicant respectfully traverses.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142.* One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j).* Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, independent claim 1 recites, in part “a temporary storage device configured to store the angle-of-view confirmation image and the in-focus confirmation image” and “a first display controller for exercising control in such a manner that the in-focus confirmation image from the

temporary storage device is displayed on the angle-of-view confirmation image also from the temporary storage device.” Miyawaki and Soohoo, individually or in combination, cannot be relied upon to teach or suggest at least this feature.

Regarding Miyawaki, it is noted that Miyawaki is entirely silent regarding a temporary storage to hold both the total image (allegedly equivalent to the angle-of-view confirmation image) and the zoomed image (allegedly equivalent to the in-focus confirmation image). Thus, even assuming *arguendo* that total image and the zoomed image as disclosed in Miyawaki is equivalent to the angle-of-view confirmation image and the in-focus confirmation image as claimed, it naturally follows that Miyawaki is silent regarding displaying in-focus confirmation image and the angle-of-view confirmation image from the temporary storage device.

Soohoo is similarly deficient. In other words, Soohoo is entirely silent regarding a temporary storage to store any types of images and is entirely silent regarding displaying the images from the temporary storage.

Since neither Miyawaki nor Soohoo can be individually relied upon to teach or suggest the feature of a temporary storage device configured to store the angle-of-view confirmation image and the in-focus confirmation image and the feature of a first display controller for exercising control in such a manner that the in-focus confirmation image from the temporary storage device is displayed on the angle-of-view confirmation image also from the temporary

storage device, the combination also cannot be relied upon to teach or suggest the same feature. For at least this reason, independent claim 1 is distinguishable over the combination of Miyawaki and Soohoo.

The Final Office Action fails in other regards as well. Another requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See *M.P.E.P. 2143.01*. In the Final Office Action (and previous Office Action), the Examiner alleges that the fourth and sixth embodiments may be combined. The alleged motivation for doing so is that the user is not fatigued by viewing both the total image and the zoomed image on the same display and is safeguarded against mistaken recognition, while the picture portion desired to be viewed may be designated easily and the picture may be seen as being magnified smoothly and continuously.

However, it is noted that the alleged motivation is not present in Miyawaki reference. Thus, the requirement that the motivation must be within the cited references is not met.

It appears that obviousness has been assumed merely on the assumption that the combination of the references includes all claimed elements. However, it is well established that even if the combination of the references teaches every element of the claimed invention, without some

motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *See MPEP 2143.01*.

In this instance, it appears that the only motivation to combine has been gleaned from the teachings of the present application. This constitutes impermissible hindsight, however. *See MPEP 2141*. Simply put, there is no showing in the Final Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention. *See MPEP 2143*.

For at least the above stated reasons, independent claim 1 is distinguishable over the combination of Miyawaki and Soohoo.

Independent claim 8 recites, in part “temporarily storing the angle-of-view confirmation image and the in-focus confirmation image in a temporary storage device” and “displaying the in-focus confirmation image from the temporary storage device on the angle-of-view confirmation image also from the temporary storage device.”

It has been clearly demonstrated above that Miyawaki and Soohoo, individually or in combination, cannot be relied upon to teach or suggest at least this feature. Therefore, independent 8 is distinguishable over the combination of Miyawaki and Soohoo.

Independent claim 11 recites, in part “a temporary storage device for storing the image of the subject and the focus image” and “a display unit for

displaying the image of the subject retrieved from the temporary storage device and the enlarged focus image also retrieved from the temporary storage device.”

It has been clearly demonstrated above that Miyawaki and Soohoo, individually or in combination, cannot be relied upon to teach or suggest at least this feature. Therefore, independent 11 is distinguishable over the combination of Miyawaki and Soohoo.

Claims 2, 4, 6-7, 9-10 and 12-19 depend from independent claims 1, 8 or 11 directly or indirectly. Therefore, for at least the reasons stated above with respect to the independent claims, these dependent claims are also distinguishable over the combination of Miyawaki and Soohoo.

Applicant respectfully requests that the rejection of claims 1-2, 4, 6-8 and 9-19 based on Miyawaki and Soohoo be withdrawn.

§ 103 REJECTION – MIYAWAKI, SOOHOO, SUZUKI

Claim 5 stands rejected under 35 USC 103(a) as allegedly being unpatentable over Miyawaki in view of Soohoo and in further view of Suzuki (USP 6,111,605). *See Final Office Action, item 4.* Applicant respectfully traverses.

It is noted that claim 5 depends from independent claim 1. It has been shown above that independent claim 1 is distinguishable over the combination of Miyawaki and Soohoo. Suzuki has not been, and indeed cannot be, relied upon to correct for at least the above-noted deficiencies of Miyawaki and

Soohoo. Thus, independent claim 1 is distinguishable over the combination of Miyawaki, Soohoo and Suzuki. For at least due to the dependency thereon, claim 5 is also distinguishable over the combination of Miyawaki and Suzuki.

Applicant respectfully requests that the rejection of claim 5 based on Miyawaki and Suzuki be withdrawn.

NEW CLAIMS

Claims 20-33 have been added through this Reply. All new claims are believed to be distinguishable over the cited references, individually or in any combination. For example, the new claims 20-25 depend from independent claims 1, 8 or 11.

New independent claim 26 recites, in part “a temporary storage device configured to store the angle-of-view confirmation image and the in-focus confirmation image from the image data conversion unit” and “a display unit configured to display one or both of the angle-of-view confirmation image and the in-focus confirmation image retrieved from the temporary storage.”

New claims 27-33 depend from independent claim 26.

Applicant respectfully requests that new claims 20-33 be allowed.

Reply to Office Action dated July 13, 2005


CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: 


MRC/HNS/sks

Michael R. Cammarata
Reg. No. 39,491
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000